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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,216	06/24/2004	Yuichi Hikichi	61534 (46342)	3278
21874	7590	09/22/2006	EXAMINER	
EDWARDS & ANGELL, LLP			MEAH, MOHAMMAD Y	
P.O. BOX 55874			ART UNIT	
BOSTON, MA 02205			PAPER NUMBER	

1652

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/500,216

Applicant(s)

HIKICHI ET AL.

Examiner

Mohammad Meah

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 28 August 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: \_\_\_\_\_.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
see the attachment.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

The claims 12, 19, 23-27 are pending in the instant office action.

### ***Claim Rejections***

Applicants amendments of claims 12 and 23 have not been entered because of the amendments raises a new issue ( breast cancer) which require further search of prior art.

Applicant's arguments against 103(a) rejection are considered but not found persuasive as explained above and bellow:

Applicant argue that there is no motivation to combine Jenuwein et al. (US PAT 6555329 B2) with Jenuwein et al. (US PAT 6689583). This is not true as **Jenuwein et al. (US PAT 6689583) suggested the use of SEQ ID NO: 4 to identify modulators of histone methyl transferase and use them to inhibit tumor growth ( page 14 paragraph 20-45). Therefore one will motivated to use Jenuwein et al's (US PAT 6689583) histone methyltransferase protein of SEQ ID NO: 4 and Jenuwein et al's (US PAT 6555329 B2) assay method to screen modulators of histone methyl transferase as therapeutic agent for cancer and apoptosis.**

Applicant's arguments against 103(a) rejection of claims 24-25 and 27 under 35 U.S.C. 103(a) by Kouzarides et al. (WO 02/090578) in view of Jenuwein et al. (US PAT 6689583) are considered but not found persuasive as explained above and bellow:

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Kouzarides et al. teaches methods of screening modulators of histone methyl transferase by measuring the methylated and unmethylated histone polypeptide reacted with s-adenosyl-L-methionine in presence of test compound using MALDI Mass spectrometry (merely an assay method) and suggested the test compound as therapeutic agent for cancer and apoptosis inducer.

**Jenuwein et al. suggested the use of SEQ ID NO: 4 to identify modulators of histone methyl transferase and use them to inhibit tumor growth ( page 14 paragraph 20-45). Jenuwein et al. also suggested the use of Mass spectrometry ( merely an assay method) to identify modulators Suv39h ( SEQ ID NO: 4 (Page 12 paragraph 12-30).**

As such it would have been obvious to one of ordinary skill in the art to use Jenuwein et al's (US PAT 6689583) histone methyltransferase protein of SEQ ID NO: 4 (which has 100% sequence identity with the SEQ ID NO: 1 of the present application) and use MALDI Mass spectrometry as an assay method taught by Kouzarides et al. to screen modulators of said histone methyl transferase.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **ONE MONTH** from the mailing date of this action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Meah whose telephone number is 571-272-1261. The examiner can normally be reached on 8:30-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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Examiner, Art Unit 1652

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